

Applicant: Rudnick et al.
Application Serial No.: 10/775,536
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REMARKS

Initially, it is noted that the Examiner indicates that the original claims filed on February 10, 2004 included claims 1-18. During subsequent prosecution, claims numbering 19-53 have been added. For clarity, Applicant filed the current claims in the present application as claims 54-60. While Applicant acknowledges that the original application was filed with 18 claims, the claim numbering used herein is believed to avoid any confusion with any previous related applications.

The Examiner has objected to the specification under 35 U.S.C. §132(a) alleging that it introduces new matter into the disclosure. The Examiner finds that certain limitations included in independent claims 54, 55, and 60 are not supported by Applicant's specification as originally filed. This determination is respectfully traversed.

In reviewing the Examiner's rejection of the independent claims, it appears that the Examiner finds that the limitation in each of the claims relating to the ability of the apexes of the stent to move longitudinally relative to the graft, is not supported by specification. The Examiner refers to Applicant's specification at page 12, where the stent/graft combination is described. The Examiner further states that there is no reference to how the graft is attached to the stent nor that the graft may be attached in part thereby allowing the unattached apexes to

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move longitudinally relative to the graft component. This determination is respectfully traversed.

Applicant's specification at page 12 clearly states that the stent is supported to the membrane covering with little support necessary at the flexible central section of the stent. Thus, since there is "little support" at the central section of the stent, the stent must inherently be able to move, in part, with respect to the covering. Thus, it is submitted that no new matter has been entered into the disclosure by way of the independent claims presented herein and furthermore, that the independent claims are supported by the disclosure of the original application.

It has been held that the new matter provision of 35 U.S.C. §132(a) is closely related to the first paragraph of 35 U.S.C. §112 requiring that the specification supports the claims. *Penwalt Corp. v. Axona Inc.*, 740 F.2d 1573, 222 U.S.P.Q. 833 (Fed. Cir. 1984). Moreover, the Federal Circuit has used this requirement to assure that the patentee had in possession, at the time of filing, the subject matter subsequently claimed. *Moba B.V. v. Diamond Automation Inc.*, 325 F.3d 1306, 66 U.S.P.Q. 2d 1429 (Fed. Cir. 2003).

It has been further held that a patent specification must set forth enough detail to allow a person of ordinary skill in the art to understand what is claimed and to recognize that the inventor invented what is claimed. *University of Rochester v. G.D. Searle and C., Inc.*, 358 F.3d

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916, 69 U.S.P.Q. 2d 1886 (Fed. Cir. 2004). This requirement has been interpreted to mean that, in the reading of the original specification, would one skilled in the art immediately discern the invention at issue. In that regard, the length of the disclosure is immaterial to the written description requirement.

In the present instance, the specification, albeit short, completely describes that the stent supports the membrane covering with little support necessary at the more flexible central section of the stent. One skilled in the art would recognize that, at least in part, the stent would move with respect to the graft covering. As such, the independent claims of the present application are believed to be adequately supported by the written description of the specification. The Examiner's objection to the specification under 35 U.S.C. §132(a) is believed to be overcome. Reconsideration is respectfully requested.

The Examiner has rejected claims 54-60 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,517,570 to Lau. Inasmuch as Applicant has argued that the claims of the present invention are supported by the specification as originally filed on August 12, 1994 and as Lau has an effective date of August 31, 1994 which is subsequent to the effective date of the present application, the Lau reference is not statutorily citable against the claims of the present application.

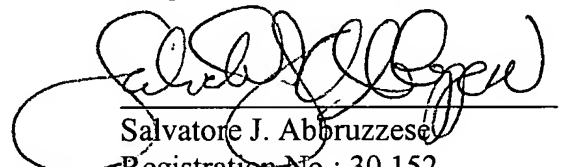
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Therefore, having removed Lau as an effective reference, the claims of the present application are believed to be patently distinct and the application, including claims 54-60 is in condition for allowance. Favorable action thereon is respectfully solicited.

The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 20-0776. Such authorization includes authorization to charge fees for extensions of time, if any, under 37 C.F.R. § 1.17 and also should be treated as a constructive petition for an extension of time in this reply or any future reply pursuant to 37 C.F.R. § 1.136.

Should the Examiner have any questions regarding this response, the undersigned would be pleased to address them by telephone.

Respectfully submitted,



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